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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/903,785	07/13/2001	Laurence Sebillotte-Arnaud	210374US0	1492
22850	7590	08/21/2008		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER				
OGDEN JR, NECHOLUS				
ART UNIT		PAPER NUMBER		
1796				
NOTIFICATION DATE		DELIVERY MODE		
08/21/2008		ELECTRONIC		

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/903,785  
Filing Date: July 13, 2001  
Appellant(s): SEBILLOTTE-ARNAUD ET AL.

\_\_\_\_\_  
Richard L. Treanor  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed June 9, 2008 appealing from the Office action mailed October 2, 2007.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows: The statement at paragraph 1 reads "Whether claims 1-23 are obvious" should read "Whether claims 1-9, 11-21 and 23 are obvious".

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

6,277,797	Glenn, Jr. et al	8-2001
96/28140	WO	9-1996

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 112***

1. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The aforementioned claim states that the polyethylene glycol has ethylene oxide units from greater than 800. This limitation is considered new matter because appellant does not have support for the data point of 800. Applicant's specification specifically teaches a range of 10-50,000 ethylene oxide units for polyethylene glycols (see specification at page 10) and the examples show PEG-180 as an exemplified data point. Accordingly, the disclosure does not support the data point 800.

***Claim Rejections - 35 USC § 103***

1. Claims 1-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Glenn, Jr. et al WO (96/28140) or Glenn, Jr. et al (6,277,797).

2. The disclosures of WO '140 and '797 are similar. Therefore, the column and line reference is to the WO '140 reference.

Glenn, Jr. et al discloses a skin cleansing composition comprising 0.5 to 10 parts by weight of fumed silica (page 5, lines 4-37); 30-80 parts by weight of water (page 17, lines 5-11); 5-30 parts by weight of a lathering surfactant such as alkyl ether sulfate, betaines, alkyl polyglucosides and nonionic surfactants such as EO/PO block copolymer such as poloxamers and polyoxyethylene esters of fatty acids (page 15, line 34-page 17, line 4), and optionally 0.5-20% by weight of polyols such as polyethylene glycol (page 17, line 21-page 18, line 28). Glenn, Jr. et al further teach that the rheological properties of the composition include a viscosity in the range of 300 to 5000 poise (page 7, lines 1-10).

Glenn, Jr. et al do not specifically teach each of the components with sufficient specificity to anticipate the claims.

It would have been obvious to one of ordinary skill in the art to have formulated to the claimed skin cleansing composition as suggested by Glenn, Jr. et al because such skin cleansing compositions of Glenn, Jr. et al teach and require each of the claimed components such as silica, oxyalkylenated compounds, surfactants and water in their requisite proportions. Accordingly, it would have been obvious to the skilled artisan, in the absence of a showing to the contrary at the time the invention was made, to formulate the claimed invention in view of the composition disclosed by Glenn, Jr. et al.

**(10) Response to Argument**

Appellant argues that Glenn, Jr. et al do not teach or suggest oxyalkylenated thickening agents. Rather Glenn, Jr. et al disclose polyols that are used as humectants and solutes. Further, appellant argues that Glenn, Jr. et al do not suggest incorporating the polyols in a thickening amount.

The examiner contends and respectfully disagrees because Glenn, Jr. et al teach polyols such as polyethylene glycols having ethylene oxide units up to 200 and additional polyols such as sorbitol and glycerol (see Glenn, page 17, line 21-page 18, line 28) and nonionic surfactants such as EO/PO block copolymer such as poloxamers and polyoxyethylene esters of fatty acids (page 15, line 34-page 17, line 4), Glenn, Jr. et al teach and require the same compounds. The only difference is that Glenn, Jr. et al recite the polyols as humectants and solutes, and poloxamers, polyoxyethylene esters of fatty acids as nonionic surfactants. Accordingly, the skilled artisan would clearly consider the compounds as synonymous and therefore expect them to ascertain similar characteristics. With respect to appellant's argument that the compounds of Glenn, Jr. et al are not thickening agents and not incorporated in thickening amounts, the examiner contends that since the compounds are similar then they would certainly function in the same manner, absent a showing to the contrary. Moreover, appellant provides no proportions to what amounts to a "thickening amounts" and therefore the examiner considers the proportions of said "thickening amount" obvious in the absence of a showing to the contrary.

*"An obviousness rejection based on similarity in chemical structure and function entails the motivation of one skilled in the art to make a claimed compound, in the expectation that compounds similar in structure will have similar properties." In re Payne, 606 F.2d 303, 313, 203 USPQ 245, 254 (CCPA1979).*

Appellant argues that the CTFA discloses PEG-200 as solutes and therefore are not thickeners.

The examiner contends and respectfully disagrees because CTFA discloses PEG-800, which appellant's claim as one of their many oxyalkylenated compounds as an humectants and further Glen, Jr. et al teach PEG-200 as humectants (page 17, lines 21-27) and other oxyalkylenated compounds such as polyoxyethylene esters of fatty acids and poloxamers as nonionic surfactants. Therefore, it would have been obvious to one of ordinary skill in the art to expect the polyols of Glenn, Jr. et al to have similar characteristics as the same components of the claimed invention, in the absence of a showing to the contrary and moreover said oxyalkylenated compounds disclosed in Glenn, Jr. et al suggest the same usage as the claimed ingredients according to the CTFA cited by appellant.

*The reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant. >See, e.g., In re Kahn, 441 F.3d 977, 987, 78 USPQ2d 1329, 1336 (Fed.Cir. 2006).*

Appellant argues that examples and comparative examples 1-3 show the many of the polyols of Glenn, Jr. et al compared with appellant's PEG-120 methyl glucose.

The examiner contends that criticality cannot be established because appellant's examples are not commensurate in scope with the claimed invention where appellant's oxyalkylenated compound includes several different ingredients (see claim 1) without any limitations on proportions or viscosity that are outside of the scope of Glenn, Jr. et al. The examples argued by appellant are narrowly limited to the specific PEG-120 methyl glucose in very specific proportions and further require viscosity limits.

Appellant further argues that comparative example 2 does not comprise PEG-120 and is therefore unacceptable.

Again, the comparative example is not indicative of the compositions of Glenn, Jr. et al because said composition is not commensurate in scope with Glenn, Jr. et al. Furthermore, example 2 is not commensurate in scope with the claimed invention since the claims are not limited to PEG-120 in limited proportions. Accordingly, criticality cannot be established.

*Whether the unexpected results are the result of unexpectedly improved results or a property not taught by the prior art, the "objective evidence of nonobviousness must be commensurate in scope with the claims which the evidence is offered to support." In other words, the showing of unexpected results must be reviewed to see if the results occur over the entire claimed range. In re Clemens, 622 F.2d 1029, 1036, 206 USPQ 289, 296 (CCPA 1980)*

Appellant argues that Glenn, Jr. et al do not suggest the specific oxyalkylenated compound of claim 23 excluding polyethylene glycols.

The examiner contends and respectfully disagrees and suggests that appellant's specific compound is located with the nonionic surfactants such as EO/PO block copolymer such as poloxamers and poloxamines, polyoxyethylene esters of fatty acids (page 16, lines 22-28).

Appellant argues that the specification fully satisfies the requirement of 112 first paragraph, wherein the polyethylene glycol component has ethylene oxide units greater than or equal to 800, in light of the CTFA handbook, which describes the PEG-800 as a viscosity-increasing agent.

The examiner contends that the CTFA handbook discloses PEG-800 as an anti-caking, binder, humectants, plasticisers and viscosity-increasing agent, Glenn, Jr. et al disclose polyethylene glycols as humectants, wherein the skilled artisan would expect the polyethylene glycols of Glenn, Jr. et al to function in an equivalent manner given they encompass similar characteristics. However, the fact that CTFA describes the specific PEG-800 as a viscosity-increasing agent does not satisfy the first paragraph under 112 requirement because it does not proffer support that would have been inherent for PEG-800 when the general teachings were from a range of 10-50,000 ethylene oxide units for polyethylene glycols (see specification at page 10) and the examples show only PEG-180 as an exemplified data point. Accordingly, it is not shown how PEG-800 was fully supported by appellant's disclosure.

The analysis must take into account what portion of the range is inherently supported by the disclosure. The examiner contends that appellant discovered a data point, PEG -800, in order to circumvent the disclosure of Glenn, Jr. et al in an attempt to carve out a patentable portion.

*Purdue Pharma L.P. v. Faulding Inc.*, 230 F.3d 1320, 1328, 56 USPQ2d 1481, 1487 (Fed. Cir. 2000)

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Necholus Ogden, Jr./

Primary Examiner, Art Unit 1796

Conferees:

/Harold Y Pyon/

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